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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,174	08/21/2001	Alain A. Meilland	006450-369	6436

7590 11/12/2003

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EXAMINER

LOCKER, HOWARD J

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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(111)

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on August 06, 2003

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~Claim(s)~~ The claim is is/are pending in the application.

Of the above, claim(s) is/are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ ~~Claim(s)~~ The claim is ~~is~~ rejected.

☐ Claim(s) is/are objected to.

☐ Claims are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

09/033174
PTOL-326 (Rev. 10/95)

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 (the claim) remains rejected under 35 U.S.C. 102(b) as the instant plant 'Meivaleir' was described in the following printed publications more than one year prior to the date of application for Plant Patent (August 21, 2001) in the United States:

FR PBR 0163545 (published April 10, 1997), which matured into Grant/Reg. Number 11226 (published December 10, 1999) (denomination accepted on July 10, 1997); or

QZ PBR 980546 (published on July 15, 1998), which matured into Grant/Reg. Number 4990 (published on December 15, 1999) (denomination accepted on October 4, 1999); taken in view of the admission that "***Plants of the 'Meivaleir' variety were made available to the public in France during September 1998***" and the MEILLAND RICHARDIER catalog excerpt (August 1998) submitted by applicant as Exhibit F in the papers filed March 23, 2003, which per applicant's admission "***was made available to others in France and identifies the 'Meivaleir' variety***".

(This rejection was previously set forth in paragraph 1 of the Office action mailed May 5, 2003, and remains applied as therein, the supporting rationale herein incorporated by reference.)

Contrary to applicant's arguments, a printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301, f.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex Parte Thomson*, 24 USPQ-2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications."). See also MPEP 2121.03.

It has been determined, and explicitly conceded on the record by applicant, that the above publicly available publications disclose the claimed plant variety and that said claimed variety was placed on public sale more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published applications, published grants, and accepted/published denominations, combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant. Information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publications standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. The admission of prior sale and offer for sale more than one year prior to the filing date of the instant application enables the referenced documents because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thomson*, supra. See also Cooper, "Biotechnology and the Law", Section 8.05, pages 8-15 to 8-16 (August 2000), Clark, Boardman, Callaghan ("In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.").

Contrary to applicant's assertion, the facts in the instant case are not identical to those presented in *LeGrice*. The *LeGrice* decision states "The particular question of law to be here decided is presented on stipulated facts, which, insofar as they relate to the issue, are here quoted from the record..." 133 USPQ at 367. The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere. Applicant LeGrice never stated that the claimed plants were on sale, nor did he provide copies of the catalogue publications (Brief, Appendix B, pages 10-11). It appears that the Board's conclusion that the plant was on sale and in public use in England had no basis in fact. Naturally, the applicant did not comment on this

conclusion because the Board went on to state that it was irrelevant, i.e. not the basis for the rejection.

The LeGrice Court noted that "...only an 'enabling' publication is effective as a bar to a subsequent patent. We do not agree with the view expressed by the examiner that this necessarily requires that plant publications be 'totally ignored.' " 133 USPQ at 374. The LeGrice Court concluded, "The mere description of the plant is not necessarily an 'enabling' disclosure." 133 USPQ at 378. In the instant application, there is more than a "mere description" of the plant – there is also evidence of public availability of the same more than one year before the instant application was filed. The claimed plant is within the "knowledge of those skilled in the art" by virtue of its public availability. One skilled in the art would thus have known "how to make" the claimed plant upon reading the cited publications, by purchasing a clone of the plant and asexually propagating it by cuttings or any other known method in the art. Thus, the publications provide an enabling disclosure when combined with the knowledge of the skilled artisan.

The examiner agrees that the publication "by itself" would not enable a person skilled in the art to reproduce the claimed plant. However, the availability of the plant whether through sale or other form of public availability would enable the disclosure of the printed publication.

The contention that foreign commercial availability or public use is not a bar to patentability under 35 U.S.C. 102(b) is noted but is not relevant. The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States...". There is no geographic limitation of the bar under 35 U.S.C. 102(b) to printed publications in this country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because as noted above, the current rejection under 35 U.S.C. 102(b) is based on foreign published documents ("printed publications"), as enabled by the admitted availability of the plants outside the United States more than one year prior to the date of domestic filing.

That the claimed plant was not available in the United States more than one year prior to the date of domestic filing is not relevant to patentability, as there is no geographic component of enablement. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See, for example, *Ex Parte Rinehart* 10 USPQ2d 1719, 1720 (Bd. Pat. App. & Inter. 1989), where a specification was found to be enabling even though the required biological material was not deposited, but was obtainable from specified locations in the ocean (specifically, only off the coast of Central and South America, as described in U.S. Patent 4,548,814, col. 1, lines 43-60).

Therefore, a foreign disclosure describing the claimed subject matter, published over a year prior to the filing of the domestic application, is an enabling bar under 35 U.S.C. 102(b) where the plant stock necessary for the publication could have been obtained over a year prior to the domestic filing of an application.

The argument that the *Thomson* decision is not in accordance to the law for the instant application as the *Thomson* application was drawn to a utility patent is not persuasive as *In re LeGrice*, 35 U.S.C. 161, and 36 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents also are applicable to plant patents except for the one exception set forth in 35 U.S.C. 162.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

4. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

5. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 703-308-0196.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to TC 1600 by facsimile transmission. Papers should be faxed to this TC via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is: 703-872-9306.

Howard J. Locker/hjl
November 11, 2003


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661